

REMARKS

Examination of the instant patent application in view of the above amendments is respectfully requested. Claims 1-9, 17-27, 29-47, 61, 62 and 64-70 remain pending. Claims 1-9, 17-47 and 61-70 are rejected. Claims 28 and 63 are cancelled herein without prejudice. Claims 1, 7, 17, 21, 29, 37, 61 and 62 are amended herein. No new matter has been added.

35 U.S.C. §103(a)

Claims 1-7, 17-27, 32-47 and 61-70

Claims 1-7, 17-27, 32-47 and 61-70 stand rejected under 35 U.S.C. §103(a) as being unpatentable over United States Patent 6,464,503 by Heit et al., hereinafter referred to as the "Heit" reference, in view of United States Patent 5,511,980 by Wood, hereinafter referred to as the "Wood" reference, further in view of United States Patent 6,190,175 by Pridgen, hereinafter referred to as the "Pridgen" reference. Claim 63 is cancelled herein; therefore a discussion of the rejection of Claim 63 is moot at this time. Applicants have reviewed the cited references and respectfully submit that the embodiments of the present invention as recited in Claims 1-7, 17-27, 32-47, 61, 62 and 64-70 are patentable over the combination of Heit in view of Wood, further in view of Pridgen for the following rationale.

Applicants respectfully direct the Examiner to independent Claim 1 that recites that an embodiment of the present invention is directed to (emphasis added):

An interactive educational toy apparatus comprising:
an indicium containing structure including an indicium, a back

structure, and a first attachment element; and
a base unit capable of being attached to a vertical surface, wherein
the base unit includes
a housing,
a receiving region adapted to receive the indicium containing
structure,
a processor unit in the housing,
a speaker coupled to the processor unit,
a reader coupled to the processor unit, and
a second attachment element coupled to the housing,
wherein the indicium containing structure is capable of being
attached to the base unit using the first attachment element and the base
unit is capable of being attached to the vertical surface using the second
attachment element and wherein the reader is capable of identifying the
indiciu containing structure based on the back structure in response to
the receiving region having received the indicium containing structure.

Independent Claims 17, 21, 37 and 61 recite similar limitations. Claims 2-7 that depend from independent Claim 1, Claims 18-20 that depend from independent Claim 17, Claims 22-27 and 32-36 that depend from independent Claim 21, Claims 38-47 that depend from independent Claim 37, and Claims 62 and 64-70 that depend from independent Claim 61 provide further recitations of the features of the present invention.

Heit and the claimed invention are very different. Applicants understand Heit to teach a method and apparatus for interacting with a computer using handheld objects that transmit a wireless identifying signal to the computer. Heit teaches that blocks containing alphanumeric characters or other symbols include transmission systems inside the blocks that emit a signal identifying the alphanumeric character or symbol. In particular, Heit does not teach, describe or suggest that the block includes a back structure or a structural code, as claimed. Furthermore, Heit does not teach, describe

or suggest a reader that is capable of identifying the block based on a back structure or structural code, as claimed.

With reference to Figures 4 and 5 of Heit, "each block 20 is capable of outputting a character identification signal that uniquely represents the character indicated on the upper surface of the block" (emphasis added; col. 4, lines 35-38). In particular, each block 20 includes "a transmission system 36 mounted within the block" (emphasis added; col. 5, lines 6-8). Furthermore, working platform 28 includes a number of readers 44 for receiving the character identification signal (col. 5, line 66 through col. 6, line 10).

Applicants respectfully submit that all identification of blocks as taught in Heit is performed by using wireless signal transmission between a block and the working platform. In particular, Applicants respectfully submit that Heit does not teach, describe or suggest that the block includes a back structure or a structural code, as claimed. Furthermore, Heit does not teach, describe or suggest that "the reader is capable of identifying the indicium containing structure based on the back structure" or "structural code" as claimed. Moreover, by teaching that the identification of a block is performed by using a system of wireless communication between the block and the working platform, Heit teaches away from the configuration as claimed.

Moreover, the combination of Heit and Wood fails to teach or suggest the claimed invention, because Wood does not overcome the shortcomings of Heit. Wood, alone or in combination with Heit, does not show or suggest the claim embodiments.

Wood and the claimed invention are also very different. Applicants understand Wood to teach a talking phonics interactive learning device in which the device is not able to identify indicia bearing units using a reader. Wood teaches a talking book that receives and identifies one of a number of cards having cutouts for receiving indicia bearing units placed in the talking book. In particular, indicia bearing units are not identified. Rather, the cards are identified, and pushbutton keys aligned with the cutouts are associated with different sounds.

With reference to Figure 1 of Wood, talking book 10 is shown. Talking book 10 is configured to receive and identify card 34 having at least one cutout 35 (col. 4, lines 38-39). The cutouts 35 overlie pushbutton keys 24. Depending on the identity of card 34, different sounds are assigned to pushbutton keys 24 such that interaction with a key 24 provides a particular sound (col. 5, lines 3-53). In particular, Applicants respectfully assert that Wood does not teach, describe or suggest a reader for identifying an indicium containing structure, as claimed. Moreover, by teaching a device for identifying a card and assigning sounds to the pushbutton keys based on the identity of the card, Wood teaches away from such a configuration.

In contrast, the claimed embodiments are directed toward an interactive educational toy apparatus “wherein the reader is capable of identifying the indicium containing structure based on the back structure” (emphasis added).

Moreover, the combination of Heit in view of Wood, further in view of Pridgen fails to teach or suggest the claimed invention, because Pridgen does not overcome the

shortcomings of Heit and Wood. Pridgen, alone or in combination with Heit and Wood, does not show or suggest the claim embodiments. Applicants understand Pridgen to teach a vocabulary teaching device. The vocabulary teaching device of Pridgen allows a user to record the name of an object and to play back the recording by using a switch of teaching device. In particular, Pridgen does not teach, describe or suggest an interactive educational toy apparatus including a base including a reader "wherein the reader is capable of identifying the indicium containing structure based on the back structure," as claimed. Moreover, by teaching that the device is specifically associated with a single object, Pridgen teaches away from the claimed configuration.

Therefore, in view of the claim embodiments not being shown or suggested in Heit, Wood or Pridgen, or any combination thereof, in combination with the above arguments, Applicants respectfully submit that independent Claims 1, 17, 21, 37 and 61 overcome the rejection under 35 U.S.C. § 103(a) and are therefore allowable over the combination of Heit in view of Wood, further in view of Pridgen. Applicants respectfully submit that the combination of Heit in view of Wood, further in view of Pridgen also does not teach or suggest the additional claimed features of the present invention as recited in Claims 2-7 that depend from independent Claim 1, Claims 18-20 that depend from independent Claim 17, Claims 22-27 and 32-36 that depend from independent Claim 21, Claims 38-47 that depend from independent Claim 37, and Claims 62 and 64-70 that depend from independent Claim 61. Therefore, Applicants respectfully submit that Claims 2-7, 18-20, 22-27, 32-36, 38-47, 62 and 64-70 overcome the rejection under 35 U.S.C. § 103(a), and are in a condition for allowance as being dependent on an allowable base claim.

Claims 8, 9 and 28-31

Claims 8, 9 and 28-31 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Heit in view of Wood, further in view of Pridgen, yet further in view of United States Patent 4,968,255 by Lee et al., hereinafter referred to as the "Lee" reference. Claims 8 and 9 are dependent on independent Claim 1 and Claims 28-31 are dependent on independent Claim 21. Claim 28 is cancelled herein; therefore a discussion of the rejection of Claim 28 is moot at this time. Applicants have reviewed the cited references and respectfully submit that the embodiments of the present invention as recited in Claims 8, 9 and 29-31 are patentable over the combination of Heit in view of Wood, further in view of Pridgen, yet further in view of Lee, for the following rationale.

As described above in the remarks accompanying the discussion of the rejection of Claims 1-7, 17-27, 32-47 and 61-70 under the combination of Heit in view of Wood, further in view of Pridgen does not describe, teach or suggest the invention as claimed.

Furthermore, the combination of Heit in view of Wood, further in view of Pridgen, yet further in view of Lee fails to teach or suggest the claimed invention, because Lee does not overcome the shortcomings of Heit in view of Wood, further in view of Pridgen. Lee, alone or in combination with Heit in view of Wood, further in view of Pridgen, does not show or suggest the claim embodiments. Applicants understand Lee to teach an electronic instructional apparatus that uses input surfaces of an answer block to provide

responses to questions. The answer blocks of Lee include input surfaces identifying the identifiable visual indicia included on the display face.

Applicants respectfully submit that the combination of Heit in view of Wood, further in view of Pridgen, yet further in view of Lee fails to teach or suggest the present invention as claimed because the combination of Heit and Lee does not satisfy the requirements of a *prima facie* case of obviousness. In order to establish a *prima facie* case of obviousness, the prior art must suggest the desirability of the claimed invention (MPEP 2142). In particular, “if the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious” (emphasis added) (MPEP 2143.01; *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959)). Moreover, “[i]f the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed amendment” (emphasis added) (MPEP 2143.01; *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984)).

As described above, Applicants understand Heit to teach that blocks containing alphanumeric characters or other symbols include transmission systems inside the blocks that emit a signal identifying the alphanumeric character or symbol. In particular, the principle of operation of Heit is to identify a block based on a character recognition signal emitted by the block and received wirelessly at a reader. Applicants respectfully assert that modifying the blocks of Heit to include identification surfaces of Lee and to modify the working platform of Heit to include detection sensors of Lee would render

Heit inoperable for its intended purpose of wireless signal transmission. Furthermore, such a modification would also render Heit inoperable for its intended purpose of including character identification completely within the block. Therefore, Applicant respectfully asserts that there is no suggestion to modify the teachings of Heit and Lee as suggested by the Examiner, as Heit teaches away from the modification as suggested by the Examiner.

Applicants respectfully disagree with the Examiner's assertion that "Heit states that his indicium identification means may be of any know [sic] technologies (col. 5, lines 4-6 and 43-45)" (see Detailed Action mailed March 24, 2006, page 4, last paragraph). Applicants note that Heit states that "[i]t is understood that various other technologies may be used to generate the character identification signal with working platform 28" (emphasis added; col. 5, lines 43-45). Applicants respectfully submit that while other known technologies may be used to generate the character identification signal, Heit specifically requires the generation and transmission of such a signal. In contrast, Lee does not teach, describe or suggest the generation of a character identification signal as required by Heit. Accordingly, Applicants respectfully submit that there is no suggestion to modify the teachings of Heit and Lee as suggested by the Examiner, as Heit teaches away from the modification as suggested by the Examiner.

Therefore, in view of the claim embodiments not being shown or suggested in either Heit, Wood, Pridgen or Lee, or any combination thereof, in combination with the above arguments, Applicants respectfully submit that independent Claims 1 and 21 overcome the rejection under 35 U.S.C. § 103(a) and is therefore allowable over the

combination of Heit in view of Wood, further in view of Pridgen, yet further in view of Lee. Applicants respectfully submit that the combination of Heit in view of Wood, further in view of Pridgen, yet further in view of Lee, also does not teach or suggest the additional claimed features of the present invention as recited in Claims 8 and 9 that depend from independent Claim 1 and Claims 29-31 that depend from independent Claim 21. Therefore, Applicants respectfully submit that Claims 8, 9 and 29-31 overcome the rejection under 35 U.S.C. § 103(a), and are in a condition for allowance as being dependent on an allowable base claim.

CONCLUSION

Based on the amendments presented above, Applicants respectfully assert that 1-9, 17-27, 29-47, 61, 62 and 64-70 overcome the rejections of record and, therefore, Applicants respectfully solicit allowance of these Claims.

The Examiner is invited to contact Applicants' undersigned representative if the Examiner believes such action would expedite resolution of the present Application. Please charge any additional fees or apply any credits to our PTO deposit account number: 23-0085.

Respectfully submitted,
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